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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/766,295

01/27/2004

Guy E. Horne JR.

02579-P0027B

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09/14/2007

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

09/14/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,295

Applicant(s)

HORNE ET AL.

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 3, 2007 has been entered.

Notice of Amendment

In response to the amendment filed on July 3, 2007, amended claims 1 and 13 are acknowledged. The current rejections of the claims are *withdrawn*. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,540,669 to Abe et al. in view of U.S. Patent No. 6,749,560 to Konstorum et al.

In regard to claims 1-3, 6-7 and 10-13, Abe et al. disclose an endoscope insertion shaft comprising: a tubular member 21 having an axis and including at least

Art Unit: 3739

one aperture 25 for increasing the flexibility thereof; and a sheath comprising at least the following layer: a braided layer 22, a laminating layer 33, a wear layer 34, wherein the braided layer jackets the tubular member; and a barrier layer 231 comprising a polyester wrap disposed between the tubular member and the braided layer and jacketing the tubular member to form a seal therebetween (see Figs. 3-5 and Col. 6, Lines 22-30). Abe et al. are silent with respect to the tubular member 21 including a continuous wall to form a closed interior. Konstorum et al. disclose an analogous endoscope 10 having a shaft 14 comprised of a frame 26 and a cover 32 (see Figure 1). Frame 26 comprises a tube 40 that is preferably formed from a shape memory alloy material, such as Nitinol (see col. 3, lines 10-25). Tube 40 has slots 46 along at least part of its length where the pattern of slots can be varied and sections of slot patterns are provided, to vary the flexibility of the tube 40 (see col. 3, lines 29-51). The slots 46 provide the tube 40 with increased flexibility along the length of the first section 52 of the tube 40 (see col. 4, lines 1-5). It would have been obvious for one of ordinary skill in the art at the time the invention was made to replace the helical tubular member of Abe et al. with a continuous wall tubular member to provide an easily manufactured one-piece tube with adequate column strength, flexibility and torque resistance to be inserted into a patient's body as taught by Konstorum et al. **In further regard to claims 4-5**, Abe et al. are silent with respect to wherein the first set of apertures comprises at least one elongated aperture having an axis oriented at an angle to the axis of the tubular member and wherein the angle is in the range from zero to ninety degrees. Figure 3 of Konstorum et al. shows that the slots 46 are positioned along a line parallel to the axis

Art Unit: 3739

of the tube 40 and have an axis oriented at an angle to the axis of the tubular member, where the angle is in the range from zero to ninety degrees. Figure 3 also shows that the slots 46 are circumferentially positioned on the tube 40. It would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the endoscope of Abe et al. with various patterns of apertures in order to vary the flexibility of the tube to a desired stiffness as taught by Konstorum et al.

Response to Arguments

Applicant's arguments filed July 3, 2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a continuous seal formed the length of the insertion shaft) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As broadly as claimed, Abe et al. disclose a barrier layer 231 that forms a seal between the tubular member 21 and the braided layer 22 (see Figs. 4-5).

Art Unit: 3739

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

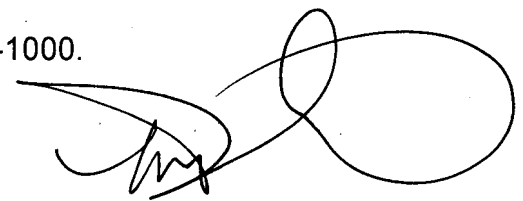
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK



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SUPERVISORY PATENT EXAMINER
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